

Serial No.: 09/876,884

RECEIVED  
CENTRAL FAX CENTER

SEP 25 2006

REMARKS

Claims 1-14 are pending in the present application. Claims 11 and 12 are amended herein to correct typographic errors. No new matter is added. The amendments do not raise new issues, and it is therefore respectfully requested that the amendments be entered. In view of the amendments and the following remarks, reconsideration and allowance of the present application are respectfully requested.

Claims 1-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,594,640 to Postrel et al. (hereinafter Postrel) in view of U.S. Patent 6,078,891 to Riordan (hereinafter Riordan). Applicants respectfully traverse.

Claim 1 relates to an order receiving apparatus that receives an order of commodity transaction from a commodity ordering apparatus through a network. The order receiving apparatus of claim 1 includes, *inter alia*, a first storage means adapted to store commodity information that includes at least a commodity name and a selling price of a commodity as an object of transaction, and a second storage means adapted to store information specifying combinations of two or more different commodities, and adapted to store specific parameters concerning economic return, which are applied respectively to said combinations, relating said information and said specific parameters, respectively. The apparatus of claim 1 also includes a third storage means adapted to store a general-purpose parameter concerning economic return, which is applied to commodities other than said combinations of commodities. The apparatus of claim 1 further includes a *means adapted to perform steps of receiving a request to display information on commodities from said commodity ordering apparatus, referring to the first storage means to output said commodity information to said commodity ordering apparatus, and referring to the second and third storage means to output information on said combinations of commodities and said specific parameters applied respectively to said*

Serial No.: 09/876,884

***combinations, and information on said general-purpose parameter to said commodity ordering apparatus.***

Regarding the rejection of claims 1-14, the Examiner maintains that Postrel and Riordan disclose all of the features of claim 1. However, Applicants respectfully submit that neither reference discloses or suggests the feature of the means adapted to perform the steps of receiving a request, referring to the first storage means, and referring to the second and third storage means. In particular, it appears that none of the references disclose or suggest the feature of means adapted to perform the step of ***referring to the second and third storage means, to output information on said combinations of commodities and said specific parameters applied respectively to said combinations, and information on said general-purpose parameter, to said commodity ordering apparatus.*** The Examiner does not even appear to allege that either of the references disclose this feature. The Examiner states that “with respect to the additional citation in the claim the currently [sic] claim language of ‘for’ is interpreted as intended use only” (Office Action; page 3, lines 7-8). However, the word “for” does not appear in claim 1, and Applicants therefore respectfully request clarification of this remark. Neither Postrel nor Riordan disclose the feature of ***means adapted to perform the step of referring to the second and third storage means to output information on said combinations and a general purpose parameter to a commodity ordering apparatus, which is readily apparent since Postrel does not disclose combinations of commodities, as admitted in the Office Action at page 3, lines 9-10, and since Riordan does not appear to disclose the second and third storage means as recited in the claim. Furthermore, neither of Postrel nor Riordan disclose or suggest receiving a request to display information on commodities, from said commodity ordering apparatus, or referring to the first storage means, to output said commodity information to said commodity ordering apparatus.***

Serial No.: 09/876,884

The Examiner is also reminded that it is the duty of the Examiner to specifically point out each and every limitation of a claim being rejected as per §1.104(c)(2) of Title 37 of the Code of Federal Regulations and section 707 of the M.P.E.P., which explicitly states that “the particular part relied on must be designated” and “the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified”.

Additionally, Applicants respectfully submit that none of the cited references disclose or suggest a second storage means adapted to store information specifying combinations of two or more different commodities, and adapted to store specific parameters concerning economic return, which are applied respectively to said combinations, relating said information and said specific parameters. The Examiner’s response does not add any material to the original citation regarding this feature, which was to Postrel figure 5, element 40. Element 40 of Postrel is a user computer which “may make a request 150 to purchase an item from an associated merchant 30” (Postrel; col. 7, lines 2-3). This feature of Postrel does not disclose or suggest a storage device adapted to store information *specifying combinations of two or more different commodities*, and adapted to store *specific parameters concerning economic return*, which are *applied respectively to said combinations, relating said information and said specific parameters*. Therefore, for at least this additional reason, claim 1 is allowable over the combination of the references, the propriety of which is respectfully not conceded.

The Examiner does not respond to our argument that the motivation to combine the references presented in the Office Action is improper. The Examiner asserts that Postrel discloses all of the features of the independent claims, except the bundling of commodities into combinations. The Examiner asserts that Riordan discloses this feature, and asserts that “it is commonly known to bundle offers” (Office Action; page 3, lines 11-12). The Office Action asserts that the motivation to combine the references is to “create unique offers that would attract

Serial No.: 09/876,884

shoppers” (Office Action; page 3, lines 15-16). However, this conclusory reasoning is insufficient to support a claim of obviousness. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either *explicitly or implicitly in the references themselves or in the knowledge generally available* to one of ordinary skill in the art. (MPEP 2143.01, emphasis added). “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). The In re Kotzab court further asserted that there must be findings as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of the invention to make the combination *in the manner claimed*.

It is respectfully submitted that the present rejection presents no proper motivation to combine the teachings of Postrel with the teachings of Riordan. There must be *specific teaching* to motivate a person of ordinary skill in the art must to combine the prior art teachings *in the particular manner claimed*. The present rejection essentially states that bundling offers is common and that creating unique offers to attract shoppers is a motivation to combine the references. However Postrel relates to a system for bartering, and Riordan relates to a system of collecting and processing marketing data. Riordan is not even directed to *attracting shoppers*, and therefore the purported teaching of bundling discussed therein does not provide a motivation to one skilled in the art to combine bundling commodities with Postrel. Therefore, since there is no motivation to combine the references, the rejection is improper.

Claims 2-6 depend from claim 1 and are therefore allowable for at least the same reasons as claim 1 is allowable.

Serial No.: 09/876,884

Additionally, claim 2 further includes a point generating means that performs steps including, *inter alia*, calculating first points when it is judged that the commodities related to the combination are included, said first points being decided based on a specific parameter applied to said combination, or based on the specific parameter applied to said combination and on selling prices of the commodities related to said combination. The Examiner asserts that Riordan's disclosure relating to combinations of commodities discloses this feature. However, as stated previously Riordan does not appear to disclose or suggest *calculating first points for combinations of items and second points for other commodities*. In fact, the section of Riordan cited by the Examiner as disclosing this feature states in its entirety:

manufacturers may at times bundle together the sale of two or more items, and assign to the bundled items a single UPC number.

(Riordan; col. 9, lines 23-25). There is no discussion in the cited section relating to *points* at all, nor more specifically is there any discussion relating to *first points for combinations* and *second points for other commodities*. Therefore, Applicants respectfully request that the rejections be withdrawn and that claim 2 be allowed.

Independent claims 7, 9-12, and 14 include features similar to those discussed above in regard to claim 1 and are therefore allowable for at least the same reasons as claim 1 is allowable.

Claim 8 depends from claim 7 and claim 13 depends from claims 11 and 12, and therefore these claims are allowable for at least the same reasons as their respective base claims are allowable.

Serial No.: 09/876,884

RECEIVED  
CENTRAL FAX CENTER

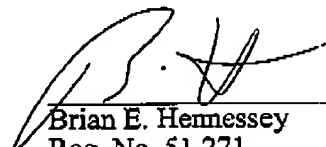
SEP 25 2006

CONCLUSION

In view of the remarks set forth above, this application is in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,

  
\_\_\_\_\_  
Brian E. Hennessey  
Reg. No. 51,271

CUSTOMER NUMBER 026304  
Telephone: (212) 940-6331  
Fax: (212) 940-8986 or 8987  
Docket: 100809-16268 (SCET 18.735)  
BEH:pm